

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

|                                   |   |                           |
|-----------------------------------|---|---------------------------|
| In re Application of:             | ) |                           |
|                                   | ) |                           |
| Andreas ROESSLER et al.           | ) | Group Art Unit: 2179      |
|                                   | ) |                           |
| Application No.: 10/676,846       | ) | Examiner: Samir Termanini |
|                                   | ) |                           |
| Filed: September 30, 2003         | ) |                           |
|                                   | ) |                           |
| For: PREDICTIVE RENDERING OF USER | ) | Confirmation No.: 3766    |
| INTERFACES                        | ) |                           |

**Mail Stop AF**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Applicants request a pre-appeal brief review of the rejections in the Final Office Action mailed on September 3, 2009. This Request is being filed concurrently with a Notice of Appeal, in accordance with the Official Gazette Notice of July 12, 2005.

Claims 1, 2, 4, 5, 7, 9, 11-15, 17-19, 21, and 22 are pending, under current examination, and the subject of this Pre-Appeal Brief Request for Review. In the Final Office Action, the Examiner rejected claims 1, 2, 4, 5, 7, 9, 11-15, 17-19, 21, and 22 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0015042 to *Robotham*.

**I. The Final Office Action Does Not Comply With MPEP § 707.07(f)**

MPEP § 707.07(f) states, "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's

argument and answer the substance of it" (emphasis added). As discussed below, the finality of the Office Action is improper because the Final Office Action does not comply with MPEP § 707.07(f).

**A. Dependent Claim 12**

Applicants filed a Reply to Office Action on June 17, 2009 ("the Reply"), pointing out numerous deficiencies of *Robotham*. In the Reply, Applicants separately traversed the rejection of dependent claim 12, pointing out several features of claim 12 that are clearly not taught or suggested by *Robotham* (Reply at page 13).

In the Final Office Action, the Examiner includes a "Response to Arguments" section, but does not address Applicants' position with respect to claim 12 (Final Office Action at pages 11-12). This failure to address Applicants' position is in contravention of MPEP § 707.07(f), because the Final Office Action clearly fails to "answer the substance" of Applicants' position.

Indeed, in the Final Office Action, the Examiner simply repeats precisely the identical language used to reject claim 12 that was used in the Nonfinal Office Action mailed April 28, 2009 (See Nonfinal Office Action at pages 8-9, Final Office Action at page 7), without ever addressing Applicants' reasoning in the Reply. Applicants submit that merely reiterating the same language in the Final Office Action cannot be characterized as answering the substance of Applicants' argument as presented in the Reply.

**B. Independent Claim 1**

Furthermore, the Final Office Action also fails to adequately address Applicants' traversal of the rejection of independent claim 1. In the Reply, Applicants amended

independent claim 1 and presented several arguments describing clear deficiencies of *Robotham* with respect to the rejected claim (Reply at pages 10-12).

The Final Office Action does not address Applicants' reasoning with respect to independent claim 1. Indeed, the Response to Arguments section of the Final Office Action is nearly identical to the Response to Arguments Section from the Nonfinal Office Action (Final Office Action at pages 12-13, Nonfinal Office Action at pages 14-15). The only apparent difference is that this section of the Final Office Action has been updated to include a copy of Applicants' arguments from the intervening Reply into the Final Office Action (Final Office Action at page 13, Nonfinal Office Action at page 14). However, the Examiner's rebuttal to Applicants' position is precisely the same in the two Office Actions, and does not include any updated reasoning to address Applicants' position from the intervening Reply.

### **C. Prosecution Should Be Reopened**

For at least the reasons discussed above, Applicants submit that the Final Office Action clearly fails to comply with MPEP § 707.07(f). Applicants made a good faith effort to advance prosecution in the Reply by presenting further arguments as to why *Robotham* does not anticipate the claims. Given that the Examiner maintained the rejection, Applicants were entitled under MPEP § 707.07(f) to receive a Final Office Action including substantive reasoning to rebut Applicants' traversals. For these reasons, Applicants respectfully request that the Examiner be required to reopen prosecution or mail a Notice of Allowance.

**II. Robotham does not anticipate the claims of this application**

Claim 1 recites a combination of elements including, for example, instructions for “estimat[ing] a likelihood for the future user interaction events to occur based on a history of previous user inputs to the user interface” (emphasis added). *Robotham* does not teach or even suggest at least this feature of claim 1.

*Robotham* discloses displaying visual content on a client device by rendering the content on a server, transforming the visual content into bitmaps compatible with the client device, and transmitting the bitmaps to the client device (*Robotham*, abstract). *Robotham* further discloses “selection events” corresponding to active choices by users at the client, and “echoing” the selection events to the server (*Robotham*, ¶ 291). The server may “pre-fetch” content related to an area of visual content related to the selection event (*Robotham*, ¶ 297).

*Robotham* also discloses client-side caching of content representations, and uses a “cache validation scheme” to determine which caches are valid (*Robotham*, ¶ 300). *Robotham* further employs an “aging threshold” to determine when content in the cache should be refreshed from the server (*Robotham*, ¶ 300). The Final Office Action relies on *Robotham*’s disclosure of caching visual content in addressing the claimed “estimating a likelihood” (Office Action at page 5).

The Examiner’s reliance on *Robotham*’s caching mechanism is improper. Those skilled in the art do not equate “caching” of data to “estimating a likelihood” that a future event will occur. The Examiner’s interpretation of *Robotham*’s caching mechanism as “estimat[ing]” a likelihood is inconsistent with MPEP 2111, which states that the

Examiner's interpretation of the claims must be consistent with both the specification and with the interpretation that those skilled in the art would reach (MPEP 2111).

Thus, as discussed above and in more detail in the Reply, *Robotham* merely discloses replacing cached content representations that have been stored in the cache for an amount of time that exceeds the aging threshold (*Robotham*, ¶ 300). However, *Robotham* fails to teach or suggest "estimat[ing] a likelihood for the future user interaction events to occur based on a history of previous user inputs to the user interface," as recited by independent claim 1 (emphasis added).

Because *Robotham* does not disclose each and every element recited by claim 1, *Robotham* cannot anticipate this claim, and claim 1 is allowable over the art of record. Claims 2, 4, 5, 7, 9, 11-13 and 22 are also allowable at least due to their dependence from claim 1.

### **III. Conclusion**

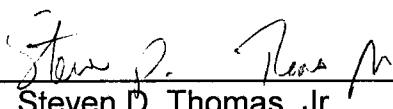
For the reasons set forth herein, Applicant requests that the Examiner reopen prosecution, withdraw the rejection, and allow the claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: October 14, 2009

By:   
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